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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,577	04/14/2004	Jung-Yao Tsai	3624-0165PUS1	5024

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EXAMINER
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SAVAGE, JASON L

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 02/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/823,577

**Applicant(s)**

TSAI, JUNG-YAO

**Examiner**

Jason L. Savage

**Art Unit**

1775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 3-5, the limitation that said bending portion of the one-piece member being preformed in a casting procedure so that steps of a following forging procedure for forming the bending portion are reduced is indefinite.

It is unclear how one could determine the number of forging steps and the reduction in the number of forging steps that may be achieved through the use of the claimed article structure since the number of forging steps used would ultimately depend on whatever structure and/or finish one desired to produce.

The claim limitation appears to be drawn to a method of using the claimed forging blank, however it is unclear how it would further define the blank structure which is claimed.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 1775

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(f) he did not himself invent the subject matter sought to be patented.

Claims 1-5 are rejected under 35 U.S.C. 102(f) as being anticipated by the admitted prior art.

Applicant states the cast golf club head blank in figures 2D and 2E is prior art formed from conventional casting process (p. 2, ln. 12-22). Applicant further states that the forging blank of the present invention can be obtained by the casting process of Figures 2A-2E (p. 6, ln. 17-22). The blank is a one-piece member which has a bending portion having first and second ends, with a club head portion and a hosel extending from the first and second ends of the bend respectively (see Figure 2D). As such, the admitted prior art anticipates the claims in that it teaches blanks which are capable of being used in a forging process which are formed by casting comprising a bending portion, a club head and hosel.

Regarding the limitation that the blank is for use in forging, statements of intended use are not considered patentably distinguishing limitations. See Ex parte Masham 2 U.S.P.Q.2d 1647, 1648. In re Thuau 135 F.2d 344, 47 U.S.P.Q. 324. Application of Hack, 245 F.2d.246, 114 U.S.P.Q. 161. Furthermore, Applicant admits that the cast blank of the admitted prior art is suitable for use in a forging process (col. 6, ln. 17-22).

Regarding the limitation that the bending portion is formed so that steps of a following forging procedure from forming the bending portion are reduced is an intended

Art Unit: 1775

use, which does not patentably distinguish the present article over the article recited in the admitted prior art.

Regarding claim 2, the head and hosel portions of the admitted prior art are substantially circular. Regarding the limitation that the circular section is for facilitating forging operation, the claim limitation is an intended use. The circular section of the prior art blank would be just as capable of facilitating a forging operation as the blank claimed by Applicant.

Regarding claim 3, the club head in Figure 2E has a sectional area greater than the hosel. Regarding the limitation that the blank is forged to form a golf club head having a striking face, the claims are drawn to the product, not the method of making. As was admitted by Applicant, the blank of the prior art is subjected to several surface finishing procedures to obtain a final product of a golf club head which would inherently have a striking face (p. 2, ln. 21 – p. 3, ln. 1).

Regarding claim 5, although Applicant states that there is difficulty with processing the claimed metal materials to form the cast blank (p. 3, ln. 16 – p. 4, ln. 3), the admission that the materials have been used to form castings anticipates the claim limitations.

Claims 1, 3-4 are rejected under 35 U.S.C. 102(b) as being anticipated by McCabe (US 6,524,194).

McCabe teaches a one-piece facing first portion blank **22** of a golf club head which comprises a bending portion, a club head portion and hosel portion (Figures 1-2).

Art Unit: 1775

Although the golf club head depicted is in a finished form, the claim does not preclude the blank from being in finished form and only requires that the golf club head have the recited structural elements. McCabe further teaches the blank may be cast (col. 2, ln. 5-6).

Regarding the limitation that the facing first portion blank is for use in forging, statements of intended use are not considered patentably distinguishing limitations. See Ex parte Masham 2 U.S.P.Q.2d 1647, 1648. In re Thuau 135 F.2d 344, 47 U.S.P.Q. 324. Application of Hack, 245 F.2d.246, 114 U.S.P.Q. 161. The claimed facing first portion of McCabe would have been just as suitable for being subjected to forging treatments as the blank claimed by Applicant.

Regarding the limitation that the bending portion is formed so that steps of a following forging procedure from forming the bending portion are reduced is an intended use, which does not patentably distinguish the present article over the article recited in the admitted prior art.

Regarding claim 3, the golf club head first portion **22** meets the claim limitation of being a golf head body having a striking face.

Regarding claim 4, the formed golf club head **20** in Figure 1 of McCabe meets the claim limitations wherein the striking face of the first portion **22** is smaller than that of the hosel portion and a weight member **28** is boned to the rear side of the striking portion.

Art Unit: 1775

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over McCabe (US 6,524,194).

McCabe teaches what is set forth above however it is silent to the structure of the intermediate golf head casting blank. However, absent a showing of unexpected results, the claimed circular cross section of the club head and hosel portions are merely design choices which do not patentably distinguish the present invention over the prior art of record. *Eskimo Pie Corp. v. Levous et al.*, 3 U.S.P.Q. 23. *In re Rose* 105 U.S.P.Q. 237. *In re Dailey* 149 U.S.P.Q. 47.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over McCabe (US 6,524,194) in view of Hsieh (US 5,167,733).

McCabe teaches that club heads are typically formed from stainless steel and other materials (col. 1, ln. 17-20) but it is silent to the use of the claimed metals. Hsieh teaches that Fe-Mn-Al alloys are useful for making castings of golf club heads (col. 1, ln. 7-13). It would have been obvious to one of ordinary skill in the art to have used Fe-Mn-Al as a material for the golf clubs heads of McCabe since it is taught as being suitable for use in such an application.

***Response to Arguments***

Applicant's arguments filed 1-9-06 have been fully considered but they are not persuasive.

Applicant argues the Admitted Prior-Art fails to disclose a blank having a bending portion preformed in a casting procedure for use in forging a golf club head. Applicant states that the Prior-Art blank 83 is not for use in a forging procedure. As set forth above, the limitation of the blank being for use in a forging procedure is merely a statement of intended use. However, Applicant admits on page 6, lines 17-22 of the specification that the cast Prior-Art blank is suitable for use a forging procedure. The blank of the Admitted Prior-Art also comprises a bending portion, a head portion and hosel portion, such as is recited in the claims. Furthermore, the claims are drawn to an article, not the method of using an article. The blank of the admitted prior art would have been just as suitable for use in a forging process as the blank claimed by Applicant, and as such, anticipates the claim limitations.

Applicant further states the Admitted Prior-Art is not the same as what is claimed since the prior art blank is intended to be subjected to several surface finishing procedures. Applicant also argues that the Admitted Prior-Art fails to disclose a combination of casting and forging procedures for forming a golf club head. As was set forth above, the claims are drawn to the article, not the method of making, the blank of the prior art meets the article claim limitations and would be just as suitable for use in a forging procedure as the blank presently claimed.



Art Unit: 1775

Applicant argues that McCabe fails to disclose a combination of casting and forging procedures for forming a golf club head. However, the claims are drawn to the article, not the method of making. The blank of the McCabe meets the article claim limitations and would be just as suitable for use in a forging procedure as the blank presently claimed.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 1775

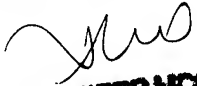
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason L. Savage whose telephone number is 571-272-1542. The examiner can normally be reached on M-F 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on 571-272-1535. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jason Savage  
2-1-06



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2/2/06